

patient; and (3) a bottom-chest panel adapted to cover at least a substantial portion of the top of the chest of the patient.

Woudenberg does not disclose a top-belt panel composed of an inextensible material. The meaning of inextensible is not capable of being extended. The Examiner asserts that Woudenberg discloses the top-belt panel (60). However, structure (60) of Woudenberg is the flexible wall section of the pressing means. Woudenberg discloses that the flexible wall section is preferably formed from reinforced rubber. Col. 4, line 54-57. The flexible wall section allows the bladder to elastically expand longitudinally. Col. 5, lines 4-11. The flexible wall section is not inextensible, and therefore, Woudenberg is missing the top-belt panel composed of an inextensible material.

In addition, Woudenberg does not disclose a belt and bladder that cover a substantial portion of the chest of the patient. Applicant's claimed belt has a width corresponding to the length of the thorax of the patient. The belt may be 10 inches in width. The claimed bladder has a width greater than the width of the belt. The bladder's width may be two inches wider than the belt such that the bladder extends one inch beyond each side of the belt. The substantial widths of the belt and bladder aid in the mechanical stability of the vest during normal operation of the vest. Furthermore, the substantial width of the belt lessens the possibility of severe lacerations caused by the "sawing" effect of the belt during normal operation. On the other hand, Woudenberg discloses a belt approximately 10 cm (4 inches) wide. Col. 5, line 45. The pressing means has a contact surface of about four inches in diameter. The belt and bladder of Woudenberg cover only the breast bone of the patient. In use, the Woudenberg device is more mechanically unstable since there is a higher possibility of the device teetering due to the small widths of the belt and bladder. Furthermore, in applicant's experience, Woudenberg's narrow belt will likely saw the patient's body, resulting in

severe lacerations after several hundred compressions during treatment and ambulance transfer to the hospital. Thus, Woudenberg does not disclose the belt and bladder covering a substantial portion of the chest of the patient.

Woudenberg does not disclose a top-belt panel composed of an inextensible material. Woudenberg does not disclose a belt and bladder that cover a substantial portion of the chest of the patient. Accordingly, claim 6 is not anticipated by Woudenberg, and therefore the rejection should be withdrawn.

The Office Action rejects claims 7 and 8 as being unpatentable over Woudenberg alone. The Examiner asserts that Woudenberg shows all the structural and functional limitations of the invention but does not specify the material choice and does not show a larger bladder. The Examiner further asserts that the material choice or size are considered obvious choices of design, either known in the art or based on user preference to suit particular applications. The Examiner's assertion that material choice or size is an obvious design choice is unfounded and improper as a substitute for the required analysis of patentability. The case of Graham v. John Deere Co., 383 U.S. 1 (1966), eliminates application of all such maxims in favor of the mandated test for patentability. The rejection based on design considerations appears to be offered as a substitute for the test required by Graham v. John Deere, which is improper. Graham v. John Deere requires identification of some pre-existing motivation to combine prior art references to achieve the claimed combination. The mere statement that, in any one person's opinion, a given element is an "obvious design choice" does not accomplish the legally required inquiry. There is no rational basis for application of such an assertion, and thus the assertion deprives the applicant of his right to have his application considered under uniform standards on par with all other applicants.

Case law mentioning the design choice issue makes it quite clear that the rejection stems from a fundamental misunderstanding of the patent law. For example, In re Chu, 66 F.3d 292 (Fed. Cir. 1995) indicates that a rejection based on design choice can be overcome by supplying evidence that the claimed combination is somehow better than the prior art. There is absolutely no requirement that an applicant's claimed invention be "better" than the prior art: it must be novel and non-obvious. An extremely valuable invention may be far worse than the prior art, but patentable nonetheless.

Additionally, as explained above, Woudenberg does not disclose a top-belt panel composed of an inextensible material and a belt and bladder that cover a substantial portion of the chest of the patient. Accordingly, claims 7 and 8 are not unpatentable over Woudenberg alone, and therefore the rejection should be withdrawn.

Claims 12 through 14 claim the limitations of the bottom-chest panel and the top-belt panel being composed of an inelastic material. Claims 12 through 14 are distinguishable from Woudenberg in that the flexible wall member allows for elastic movement of the bladder while the claimed invention does not allow for elastic movement. These limitations, in combination with the limitation of the independent claims, are novel, and the references contain no suggestion to make the combinations.

Claims 15 through 17 claim the dimensions of the belt and bladder. These limitations, in combination with the limitation of the independent claims, are novel, and the references contain no suggestion to make the combinations.

Claims 18 through 20 claim the limitation of the bladder being detachable from the belt. This limitation, in combination with the limitation of the independent claims, are novel, and the references contain no suggestion to make the combinations.

Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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